

IN THE UNITED STATES PATENT AND TRADEMARKS OFFICE



November 12, 2002

Re: Our File: 055669-0003
Invention: System, Computer Product and Method for Providing a Private Communication Portal
Application No.: 09/595,533
Filed: June 16, 2000
Country: United States
Inventors: Steven P. Meyer, Pedro P. Nascimento and Andrew Cheung
Art Unit: 2151

The Commissioner of Patents and Trademarks
WASHINGTON, D.C.
U.S.A. 20231

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Technology Center 2100

DECLARATION OF ANDREW CHEUNG

I, Andrew Cheung, the President of 01 Communique Laboratory Inc. ("01 Communique"), a company organized under the laws of the Province of Ontario, Canada, and one of the inventors of the aforementioned patent application, DULY SWEAR, DEPOSE AND SAY:

- 1) The invention described in U.S. Application No. 09/595,533 (the "Application") or the "Invention", as appropriate) was conceived of in November 15th, 1999, and reduced to practice, as of February 18th, 2000 ("Invention Date"). Specifically, as of the Invention Date, 01 Communique was operating a working prototype of the computer product and computer system in accordance with the Invention, and had commercially practised the method of the Invention by signing and/or authenticating data in accordance with the Invention.
- 2) I engaged our previous patent attorneys, Messrs. Keyser Mason Ball, LLP, to conduct a patent search of the records of the United States Patent Offices with a view to identifying prior art relevant to the Invention. Specifically, in regard to the United States, Messrs. Keyser Mason Ball, LLP conducted an in depth electronic search of the records of the United States Patent Office. They also reviewed extensive prior art that I do verily believe that the co-inventor, Mr. Steven Meyer, had accessed and identified based on his extensive knowledge of the related art. Based on the search results, Messrs. Keyser Mason Ball, LLP rendered a positive opinion regarding the patentability in the United States of the Invention, including all of the claims appended to the Application.
- 3) The search conducted by Messrs. Keyser Mason Ball, LLP identified the pieces of prior art referenced in the Information Disclosure Statement filed on February 25, 2002.

- 4) I have knowledge of prior art that is pertinent to the Invention. This is by means of routine patent searches that I conduct; review of technical articles on remote access to computer over the Internet and unified messaging; reading publications of pre product launch technical notes; canvassing on a regular basis the launch of new products in the unified messaging and remote access market space whether via the Internet, at trade shows, or through contacts in technology distribution channels, word of mouth etc. I engaged in all of the above activities prior to the filing of the Application. Based on the aforementioned knowledge, sources of information and activities, and the patentability opinion of Messrs. Keyser Mason Ball, LLP, I verily believe that both at the date of Invention and at the date of filing the Application, there was no prior art that either anticipated or in combination with the knowledge of an ordinary person skilled in the art would have rendered the Invention obvious. Without limiting the generality of the foregoing, my belief in this regard extends also to the claims appended to the Application.
- 5) I also believe that the inventors cited in the Application, including myself, were the first to invent the Invention. This is in part because during confidential and limited disclosure of the Invention to key product development executives of leaders in the unified messaging and remote access market, disclosure of the Invention was met with surprise and interest. In addition, notwithstanding the fact that 01 Communique does not have the distribution channels of some of its much larger competitors, the Invention has been commercially very well received, and also very well received by technical evaluators of technology.
- 6) GoToMyPc is a company located in Santa Barbara, California, which currently markets, distributes and sells in the United States a solution known also as "GoToMyPc" (the "Infringing Solution"). The Infringing Solution is both a computer product as well as a process for gaining remote access to a personal computer via an intermediary server. I do verily believe that the Infringing Solution was first made available on or about November, 2001.
- 7) The following is a summary of the steps/components of the Infringing Solution;
 - a) A personal computer is registered on a server.
 - b) A user who wishes to connect to their personal computer through a network-connected device contacts the server and provides password verification.
 - c) The server then locates the personal computer on the Internet and establishes a connection between the personal computer and the network-connected device.
- 8) I verily believe that the connection created as between the server and the personal computer in accordance with the Infringing Solution is established in the manner described in the Application (as particularized below). As such, I verily believe that the claims of the Application, if issued, would be infringed by GoToMyPc, including at the very least claims 1, 2, 10, 11, 13, 19 and 20, as set out below:

Claim 1 The Infringing Solution does this in steps a) – c). The Infringing Solution in accordance with these steps is also a "private communication portal".

- Claim 5 The locating facility of the Infringing Solution appears to use substantially the same means for communicating the location of the personal computer.
- Claim 6,7, The Infringing Solution appears to use a dynamic location directory, as well as one that updates the current location of personal computer periodically.
- Claim 20 The Infringing Solution implemented on a computer would have the same resources based on steps a) to c).
- Claim 25 The computer product embodied by the Infringing Solution would have the same resources based on steps a) to c) as well as the comments made in reference to Claims 5, 6 and 7.
- Claim 26 The method described is essentially the same as steps a) to c) described above.

I note that the steps of the infringing Solution identified above that read on the Claims also referenced above, in my opinion, are provided substantially in the same manner as described in the Application.

- 9) Based on the above, I believe that the Infringing Solution, specifically the computer product sold by GoToMyPc and the process implemented in this computer product, clearly mirror the pith and substance of the Invention, as well as the functionality and end result of the Invention as detailed in the Application, and therefore would infringe a patent granted on the Application.
- 10) The commercial landscape for products similar to the Invention is changing every day. In order to enforce its rights in the important innovations subsumed in the Application, immediate enforcement of a patent granted on the Application is required by 01 Communique. Otherwise, 01 Communique will suffer irreparable market loss. Therefore, any further delay of prosecution of the Application would cause tremendous prejudice to 01 Communique.
- 11) Based on the foregoing, I ask that you grant the petition for advanced examination of the Application.




ANDREW CHEUNG

DECLARATION

Andrew Cheung states that he is one of the named applicants in this matter, that he has read the foregoing Declaration by him subscribed, and that the statements contained therein are of his own knowledge are true and that all statements made on information and believe are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereof.

DATED:



ANDREW CHEUNG